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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/716,918

Filing Date: November 20, 2000

Appellant(s): WALKER ET AL.

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Jeffrey R. Ambroziak

For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 07 August 2008 appealing from the Office action mailed 08 January 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 50-54, 56-58, 60-62 64-69, and 71-77 are rejected under 35 U.S.C. 102(e) as being anticipated by Barrie (US 5,833,537).**

3. **Regarding claims 50-53, 65-68, and 71-77;** Barrie teaches generating at least one outcome wherein each outcome includes a plurality of instances selected from a plurality of machine symbols appearing on a plurality of pay-lines (Figure 1 & Abstract). The set of machine symbols including a plurality of persistent (tracked) slot machine symbols (1 24a, 124b, 124c) wherein on the occurrence of a persistent symbol a running count is adjusted in a respective counting grid (142, 144, Figure 7) respectively. The symbols of Barrie further independently expire due to the passage of time and/or the playing a predetermined number of subsequent rounds (Abstract). Barrie additionally teaches the awarding of a bonus payout as determined by the count present in the counting grid (Figure 5).

4. **Regarding claim 54;** Barrie teaches counting of tracked symbols for any payout

amount (Figure 3). As so claimed the tracking of predetermined symbols occurs for any payout amount less than the predetermined amount above the maximum payout amount. In this light the applicant's "less than a predefined amount" is equated to any amount predefined above the maximum payout amount.

5. **Regarding claim 56;** Barrie teaches remote game administration (Col4:42-4:60) including a server system (central computer) for game state operation and tracking. Barrie utilizes remote hardware game management including all related processing functionality this is understood to encompass the storage and execution of software as well as performing as a server of the game to the remotely located player.
6. **Regarding claims 57 and 58;** the claimed determination of a bonus payout based on the number of plays and/or the a duration of time is considered taught above by Barrie through the requirement of completing a grid prior to the expiration of at least one symbol presently held in the grid.
7. **Regarding claim 60;** Barrie teaches awarding payouts (Figure 3 & Element 326) in response to the count and a placed wager (312), where the count excludes expired symbols (322). (Col 5:60-65).
8. **Regarding claim 61;** Barrie teaches the use of offsetting Symbols (black ball) for decrementing the count value with each occurrence of the black ball on a persistent symbol location (Col4:8-22).
9. **Regarding claim 62;** Barrie teaches the use of multiplier symbols wherein the bonus payout includes the determination of a multiplier to be applied to the payout (Figure 4).
10. **Regarding claim 64;** Barrie teaches associating a zero payout for those symbols

which have expired (Col 8:1-10 & Abstract) and as such encompasses the claimed "determining a payout for expired occurrences of the at least one tracked symbol".

11. **Regarding claim 69;** Barrie teaches the use of a video poker embodiment including the use of playing cards (Col 3:2-5).

12. **Regarding claim 74;** Barrie teaches the incorporation of CPU (214) for the execution of game device taught above.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claims 55, 59 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie (US 5833,537) in view of Weiss (US 6,165,071).**

15. **Regarding claims 55, 59 and 63;** Barrie teaches the inclusion of a "player card" however is silent regarding the memory, tracking, and player compensation abilities capabilities of said player card (Col. 5:47-49). In a related application however Weiss teaches the use of a player card system (Weiss Col2:24-27) for allowing a player to complete a game a in a series of gaming sessions including the storage of the player's current game state (Weiss Col. 3: 11 -22), player tracking functions (Weiss Col 1 :39-67), and the determination of player rewards for continued play (Weiss Col 1 :39--56). It would have been obvious to one of ordinary skill in the art at the time of invention to have to have incorporated the continued play incentive program including the portions

described above into the system/method of Barrie in order to encourage continued game play among players.

**16. Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie (US 5833,537).**

17. **Regarding claim 70;** Barrie teaches providing a payout based on the results of a first game, the counting of predetermined symbols, and embodiments which further include the use of card games (Col 3:2-5) as taught above however Barrie is silent regarding the use of face value cards for the purpose tracked symbols. As no stated problem is solved or unexpected result obtained in the utilization of card face values in the place of the symbols of Barrie this feature is deemed to be a matter of design choice. It would have been obvious to one of ordinary skill in the art at the time of invention to utilization of card face values in the place of the symbols of Barrie in order to allow the persistent symbol feature depiction in order to correspond the persistent symbols to a desired game theme.

#### **(10) Response to Argument**

The applicant's argument for independent **claims 50,71 and 74** is that "Barrie neither teaches nor suggests: *determining a number of occurrences of the at least one tracked symbol; determining whether the number is at least a minimum number; and providing, if the number is at least a minimum number, a bonus payout*", and admits that "At most, Barrie teaches that a particular type of symbol may affect a payout, by affecting a magnitude of a multiplier applied to the payout". The examiner's broadest reasonable interpretation of the claim language understands counting the appearance of a specific symbol as tracking a symbol, determining whether the number is at least a minimum is equal to determines whether a minimum number, and a bonus payout as a special prize of Barrie column 6 lines 34-38, "*The system then determines whether a minimum number, such as all of the symbol positions on the simulated keno card, have been filled with check marks*

**518**, and, if so, a special prize **520**, based on the presence of the persistent symbols is ordered”.

Appellants assert that **claim 57** recites numerous limitations that are not taught or suggested by Barrie. Specifically, Barrie neither teaches nor suggests: *wherein determining a bonus payout further includes determining the bonus payout based on a number of plays of a slot machine*. The examiner points to Barrie column 5 lines 5-8, “For example, it may be desired to remove a persistent symbol after it has remained in place for a predetermined number of rounds of the game”, lines 33-37, “For example, a persistent symbol can be added in response to the passage of a certain amount of time or play or a certain number of rounds, without the appearance of the persistent symbol in a given position”, and lines 44-47, “Other types of delete events can be used, such as the passage of a certain amount of time or play of a certain number of games, a period of time without any game, a new player initiating a play...”, where the bonus pay that is dependent on the number of persistent tracked symbols are dependent on amount of play, number of rounds or a certain number of games. Since the bonus amount is dependent of the persistent symbols and they depend on a number of plays or games, then the bonus payout is also dependent on the, or based on the number of plays.

Appellants respectfully assert that **claim 58** recites numerous limitations that are not taught or suggested by Barrie. Specifically, Barrie neither teaches nor suggests: *wherein determining a bonus payout further includes determining the bonus payout based on a duration of time*. The examiner points to Barrie column 5 lines 5-8, “For example, it may be desired to remove a persistent symbol after it has remained in place for a predetermined number of rounds of the game”, lines 33-37, “For example, a persistent symbol can be added in response to the passage of a certain amount of time or play or a certain number of rounds, without the appearance of the persistent symbol in a given position”, and lines 44-47, “Other types of delete events can be used, such as the passage of a certain amount of time or play of a certain number of games, a period of time without any game, a new player initiating a play...”, where the bonus pay is



dependent on the number of persistent tracked symbols are dependent on amount of time, duration of play, or duration of lack of play. Since the bonus amount is dependent of the persistent symbols and they depend on time of play, then the bonus payout is also dependent on the, or based on the duration of play.

Appellants respectfully assert that **claim 64** recites numerous limitations that are not taught or suggested by Barrie. Specifically, Barrie neither teaches nor suggests: *determining a payout for expired occurrences of the at least one tracked symbol*. The examiner respectfully cites col. 8 lines 1-10 and the abstract and points out that determining a payout for expired occurrences of at least one symbol is simply determining the amount of payout of the total of the symbols and adjusting it according to the symbols left, it does not mean to pay out at that time. (fig. 6), shows items 614 a, b and c, maintaining a running score and the bonus amount during the bonus round, which is the same as determining the payout every time a symbol is added or deleted from the total.

Appellants respectfully assert that independent **claim 72** recites numerous limitations that are not taught or suggested by Barrie. Specifically, Barrie neither teaches nor suggests: *determining a count value wherein the count value is incremented when there is an occurrence of the at least one tracked symbol and the count value is decremented when an occurrence of the at least one tracked symbol expires, such that the count value may be a non-zero integer after the count value is decremented upon an expiration of an occurrence*. The examiner points to column 7 lines 5-12, where the prize or point value of a bank symbol is incremented for the appearance of the tracked symbol, and column 5 lines 39-52, where the system would decrement of a delete event were to occur.

Appellants respectfully assert that **claim 73** recites numerous limitations that are not taught or suggested by Barrie. Specifically, Barrie neither teaches nor suggests: *terminating the determining of the count value upon termination of the session of play by the player*. The examiner points to Barrie column 4 lines 8-11, "*Preferably, although the*

*persistent symbols 124a, 124b, 124c last through two or more successive rounds or spins, there is also a mechanism for deleting or removing the persistent symbols 124a 124b, 124c at some point"*, and column 5 lines 44-49, "*Other types of delete events can be used, such as the passage of a certain amount of time or play of a certain number of games, a period of time without any game, a new player initiating a play...*", wherein Barrie discloses that the system has the ability of removing all persistent symbols, and that such removal could be triggered by any event such as a player initiating or terminating play on a game.

Appellant notes that as claim 70 depends upon claim 50, and incorporate all of the elements and limitations of claim 50, the rejection of claim 70 must likewise be withdrawn. As expressed above the rejection of claim 50 stands and thus this argument is not persuasive.

In addition, Appellants note that claim 70 recites *wherein the at least one tracked symbol comprises a function of the face value of cards dealt in a hand*. Assuming, arguendo, that it would have been obvious to utilize card face values in the place of symbols, such is not recited in claim 70. The examiner views Barrie's disclosure of differentiating a Red Ball from a Black Ball to signify that symbols may be differentiated by more than the icon they represent, but by a function, as per in the poker cards, a seven could be red or black, or Diamond or Spade and tracked in the manner in which the inventor chooses, red cards, diamond cards or sevens. As iterated in the rejection of claim 70, this is a simple design choice from the limited choices involving playing cards, once including that Barrie's invention is not limited to slot machine but explicitly includes card games.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Frank M. Leiva/  
Examiner, Art Unit 3714  
Frank Leiva

Conferees:

/Scott E. Jones/  
Primary Examiner, Art Unit 3714

/Dmitry Suhol/  
Supervisory Patent Examiner, Art Unit 3714

/Peter Vo/  
Supervisory Patent Examiner, Art Unit 3714